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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHAO, MICHAEL W

ART UNIT

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4121

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/591,556	Applicant(s) LI ET AL.	
	Examiner Michael Chao	Art Unit 4121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☒ Claim(s) 2-6, 9-11, 13-14, 16, 19-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/31/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Construction

1. Claim 26, 27 contain the phrase means or step for. It has been construed as covering the corresponding structure, material, or acts described in the specification and equivalents thereof.

Claim Objections

1. Claims 2-6, 9-11, 13-14, 16, 19-20 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. These claims do not further limit the method from which they are dependent upon.
2. Claim 2 recites an "RSD program adapted to ... ", adapted to does not positively limit the invention, thus the only limitation in this claim is the 'RSD program'. This element is not a step, and therefore fails to further limit the method claim 1.
3. Claims 3-6, 16, 19-20 do not recite any further step to limit the parent claim 1.
4. Claims 13-14 list the elements of 'RSD server program' and 'mobile computer' which do not further limit the steps of, establishing, selecting a content file, selecting a remote site, receiving, packing, sending, or using the packed information. They do not recite any further step to limit the parent claim 1.
5. Claims 23-24, 27, 29 appear to be depending upon the wrong claims.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 22-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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4. Claims 22-27 recite a system with methods of using the system. Recitation of both a system and the method for using the system does not apprise a person of ordinary skill in its scope. See *IPXL Holdings LLC v. Amazon.com Inc.* 77 USPQ2d 1140 (Fed. Cir. 2005).

Claim Rejections - 35 USC § 101

1. Claims 22-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
2. The claimed subject matter of claims 26-29 is limited to a 'means for providing', a 'means for transmitting', a 'plug-in program' and a 'web browser', which are none of a process, machine, manufacture, nor composition of matter; it is therefore nonstatutory.
3. Claims 22-27 recite a system with methods of using the system. A claim that is directed to neither a "process" nor a "machine", but rather embraces or overlaps two different statutory classes of invention is nonstatutory, 35 U.S.C. 101 sets forth the statutory classes of invention in the alternative only. See *Ex parte Lyell* 17 USPQ2d 1548 (Bc. Pat. App. & Inter. 1990) and MPEP 2173.05(n)

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by Dell™.

7. With respect to claim 22, Dell™ produces computers that are; A system for remote site downloading (RSD) comprising a local computer (Dell makes many types of local computers) adapted to (The phrase "adapted to" does not limit a claim to a particular structure and does not limit the scope of a claim or claim limitation. See MPEP 2105(II)) enable selection of a geographic drive and for packing information comprising a session cookie and a URL and sending the packed information to a remote site computer for automatic downloading of a content file selected during a session between the computer and a content server.

8. Claims 1-9, 11, 13, 15, 16, 18-20, 22-27, 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Slotznick.

9. With respect to claim 1, Slotznick teaches; A method for remote side downloading (RSD) comprising:
establishing a session between a local computer and a content server having a URL;
("the TV Phone allows the user to surf the Internet" paragraph [0016])
selecting a content file to be downloaded from the content server; ("the telephone device includes a display screen which displays content" paragraph [0092])
selecting a remote site geographic drive to which the content file is to be downloaded from the content server; ("transmit data to a nearby television screen or computer

screen to be displayed” paragraph [0016])

receiving at least one cookie of the session; (“an electronic address of the content are stored in the telephone device” paragraph [0093])

packing information comprising the cookie of the session and the URL; (“the electronic address of the content is communicated from the telephone device to the local control device” paragraph [0095])

sending the packed information to a remote site computer; (paragraph [0095])

wherein the remote site computer uses the packed information to download the selected content file to the selected geographic drive. (“the local control device receives the signal and transmits a request over an electronic network to retrieve the content” paragraph [0096])

10. Regarding claim 2, Slotznick teaches; wherein the local computer has a RSD program adapted to pack the information and send the information to a remote site computer. (“the electronic address of the content is communicated from the telephone device to the local control device” paragraph [0095])

11. Regarding claim 3, Slotznick teaches; wherein the RSD program is a plug-in in a web browser. (paragraph [0016])

12. Regarding claim 4, Slotznick teaches; wherein the cookie is a set of data, comprising information selected from the group consisting of authentication information, authorization information, and session duration information. (“input from the phone may . . . enables the set-top box to descramble a pay per view movie or channel (while charging the user’s account or credit card)” paragraph [0030])

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13. Regarding claim 5, Slotznick teaches; wherein the session is a web session.
(paragraph [0016])

14. Regarding claim 6, Slotznick teaches; wherein the cookie is a web browser cookie. (paragraph [0093])

15. Regarding claim 7, Slotznick teaches; wherein the content file is represented by the URL and the URL which comprises the packed information identifies the selected content file for the remote site computer. (paragraph [0095])

16. Regarding claim 8, Slotznick teaches; wherein the local computer establishes the session via a first access network and the remote computer downloads the content file via a second access network. ("the phone line is the input and output for the telephone portion of the TV Phone. The cable from the television is used to send the signal from the TV blinking interval" paragraph [0019])

17. Regarding claim 9, Slotznick teaches; wherein the geographic drive is at a fixed location. (paragraph [0095])

18. Regarding claim 11, Slotznick teaches; wherein the geographic drive is at a hotspot. ("in an alternate embodiment, the wireless transmitter is built into the TV and is not a separate set-top box" paragraph [0024])

19. Regarding claim 13, Slotznick teaches; wherein the remote site computer has an RSD server program to download the file from the content server using the URL and the session cookies (paragraph [0096]) or assigns a caches server to download the file from the content server and store the file until the computer associated with the geographic drive is available to receive the content file from the cache server.

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20. Regarding claim 15, Slotznick teaches; wherein the session between the local computer and the content server is a secured session and the content file is purchased using a credit card, wherein the content server uses session control cookies to assure that the downloading request is authentic. (paragraph [0030])

21. Regarding claim 16, Slotznick teaches; wherein the geographic drive is a location dependent storage on a local computer comprising a map containing data comprising one or more of a name of an associated network, (paragraph [0019]) a user ID of the associated access network, a password of the associated access network, a geographical location of a static location or a dynamic hotspot location, and an RSD assignment command comprising executables and parameters to be made when the geographic drive is accessed.

22. Regarding claim 18, Slotznick teaches; wherein the local computer uses a web browser with an RSD plug-in to establish the session with the content server.
(paragraph [0016])

23. Regarding claim 19, Slotznick teaches; wherein the content file is a multimedia file. (paragraph [0030])

24. Regarding claim 20, Slotznick teaches; wherein the content file is a movie file.
(paragraph [0030])

25. With respect to claim 22, Slotznick teaches; A system for remote site downloading (RSD) comprising a local computer adapted to enable selection of a geographic drive (paragraph [0016]) and for packing information comprising a session cookie and a URL (paragraph [0095]) and sending the packed information to a remote

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site computer (paragraph [0095]) for automatic downloading of a content file selected during a session between the computer and a content server. (paragraph [0096])

26. Regarding claim 23, Slotznick teaches; wherein the local computer has a web browser with an RSD plug-in. (paragraph [0016])

27. Regarding claim 24, Slotznick teaches; wherein the local computer is a mobile device (paragraph [0016]) and the remote site computer has a broadband connection, (paragraph [0019]) wherein the broadband connection is wireless or wired. (paragraph [0019])

28. Regarding claim 25, Slotznick teaches; A system for facilitating remote site downloading (RSD) of a content file selected using a first computer from a content web server for downloading to a remote computer geographic drive comprising programming in the first computer comprising a browser RSD plug-in (paragraph [0016]) which enables identification of a remote computer geographic drive for receiving and storing the selected content file, (paragraph [0016]) packs information comprising a cookie, and sends the packed information comprising the cookie to the remote computer, (paragraph [0095]) the packed information comprising a cookie functioning to cause the remote computer to automatically requested the content web server to download the content file to the geographic drive. (paragraph [0096])

29. With respect to claim 26, Slotznick teaches; A system for facilitating the transferring a content file from a web content server to a geographic drive on a remote site computer comprising means for providing a proxy comprising a cookie and a URL

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which controls the downloading of the content file from the web content server; and means for transmitting the proxy to the remote site computer. (paragraph [0095])

30. Regarding claim 27, Slotznick teaches; wherein the means for providing the proxy comprises a web browser having an RSD plug-in. (paragraph [0016])

31. Regarding claim 29, Slotznick teaches; A web browser having the plug-in program of claim 27. (paragraph [0016])

32. Claims 1, 10, 12, 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Henrick (U.S. 6,507,727).

33. With respect to claim 1 Henrick teaches; A method for remote side downloading (RSD) comprising:

establishing a session between a local computer and a content server having a URL; (“over the Internet” column 1 line 63)

selecting a content file to be downloaded from the content server; (“the system allows the user to order the desired content using a wireless device” column 2 lines 1-3)

selecting a remote site geographic drive to which the content file is to be downloaded from the content server; (“The user preferably pre-registers with the Web site, typically from the second device” column 2 lines 12-13)

receiving at least one cookie of the session; (“then downloads a screen to the user’s wireless device that displays information concerning the broadcast content . . .” column 2 lines 33-34)

packing information comprising the cookie of the session and the URL; (column 2 lines 33-34)

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sending the packed information to a remote site computer; (“ . . . to the second device” column 2 lines 34-35)

wherein the remote site computer uses the packed information to download the selected content file to the selected geographic drive. (“the Web site contacts the software agent in the second device and arranges for download and archiving of that content” column 2 lines 37-39)

34. Regarding claim 10, Henrick teaches; wherein the geographic drive is at a dynamic location. (“In another preferred embodiment, connection to the device receiving the download may be via wireless Internet connection” column 6 lines 45-47. Since the computer is wirelessly connected it is easily mobile.)

35. Regarding claim 12, Henrick teaches; wherein the remote site computer downloads the file from the content server using the URL and the session cookies and stores the content file in a cache server until the computer associated with the geographic drive is available to receive the content file from the cache server. (“In a preferred embodiment, software agent 112 may be adapted to automatically transfer the file to another device for portability or archive. In this preferred embodiment, in step 418, software agent 112 searches for the availability of the device and, if available, transfers the downloaded song to it.” Column 5 lines 46-54)

36. Regarding claim 14, Henrick teaches; wherein the geographic drive is a mobile computer and the remote site computer is a cache server at a hotspot, (“column 6 lines 45-47) and the cache server has an RSD server program that receives the packed information, downloads the selected content file from the content server using the URL

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and the session cookies, stores the content file until the mobile computer signs in at the hotspot and then downloads the content file from the cache server to the mobile computer geographic drive. (column 5 lines 46-54)

37. Claims 17, 21, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slotznick et al. (U.S. 2001/0055951).

38. Regarding claim 17, Slotznick teaches; wherein the geographic drive map provides the address, (It is inherent that a network device will have an address.) user ID, password, and the RSD assignment. (paragraph [0030]). Slotznick does not explicitly teach; geographical location. It would, however, have been obvious that such information should be provided to the kiosk of Figure 15 to determine the efficacy of the content being presented at that location. A person would have done this by storing the actual location of the kiosk. It would have been obvious at the time the invention was made to a person of ordinary skill in the art to store the location of the kiosk in order to compare usage data at various locations.

39. Regarding claim 21, Slotznick does not teach; wherein the packed information is sent to the remote site computer as an instant message, an e-mail with an attachment comprising the packed information, or an HTTP request. However it would have been obvious to use HTTP to transmit data. A person of ordinary skill in the art would have done this by using HTTP to transfer all media request data between the TV Phone and the base station. It would have been obvious at the time the invention was made to a person of ordinary skill in the art to use HTTP as a transfer protocol in order to bypass typical firewalls, and because it is a well known standard.

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40. Regarding claim 28, Slotznick teaches; A plug-in program for a web browser to be employed on a local computer, the plug-in program enabling transfer of a content requesting session between the local computer and a content web server by packing information comprising one or more cookies received on the local computer from the content web server and a URL for the requested file on the content web server, (paragraph [0095]). Slotznick does not teach; sending the packed information by instant messenger, an e-mail with the information attached, or an HTTP request. However it would have been obvious to use HTTP to transmit data. A person of ordinary skill in the art would have done this by using HTTP to transfer all media request data between the TV Phone and the base station. It would have been obvious at the time the invention was made to a person of ordinary skill in the art to use HTTP as a transfer protocol in order to bypass typical firewalls, and because it is a well known standard.

41. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Mensch (U.S. 2002/0133824) teaches a wireless entertainment system.
- b. Shteyn et al. (U.S. 2003/0069964) teaches a digital content catering system.
- c. Jones et al. (U.S. 6,697,944) teaches a digital content distribution system.
- d. Nakayama et al. (U.S. 2004/0147251) teaches a communication terminal.
- e. Lindskog et al. (U.S. 7,043,456) teaches a mobile electronic transaction proxy.

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- f. Slate (U.S. 7,113,981) teaches a cellular telephone download locker.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Chao whose telephone number is (571)270-5657. The examiner can normally be reached on Monday - Thursday, 8:00am-4:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Robertson can be reached on (571)272-4186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. C./
Examiner, Art Unit 4121

/DAVID L. ROBERTSON/
Supervisory Patent Examiner
Art Unit 4121